



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,444	08/15/2001	Koichi Ito	0425-0847P	9635

2292 7590 09/24/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,444

Applicant(s)

ITO ET AL.

Examiner

Bruck Kifle, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16,24-26 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16,24-26 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1624

Applicant's amendments and remarks filed 7/7/03 have been received and reviewed.

Claims 1-16, 24-26 and 32 are now pending in this application.

Claim Rejections - 35 USC § 112

Claims 1-16, 22-26, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) The term "heteroaryl" is still indefinite because it is not known what the heteroatoms are.
- ii) The substituents on R¹ and R² need to be included within the claims. Applicants are reminded that although the claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1991)). Accordingly, without the recitation of all these critical limitations, the claims do not adequately define the instant invention.

Claims 24-26 are again rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for treating and ameliorating nerve degeneration diseases generally. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Treating and ameliorating nerve degeneration diseases generally is prima facie not enabled because diseases such as Alzheimer's disease, ALS, Parkinson's, etc. are all embraced and these diseases vary widely in terms of cause and treatment. Applicants argue that the test data in the specification is sufficient. However, the test Applicants are relying on are not accepted tests for any and all nerve degeneration disease. Since this assertion is contrary to what is known in medicine, proof must be provided that this

Art Unit: 1624

revolutionary assertion has merits. Where extensive efforts have all failed, it is reasonable for the Patent and Trademark Office to require proof that the claimed invention actually works for this specific utility. It is well established that a utility rejection is proper when scope of enablement is not reasonably correlated to the scope of the claims. (In re Vaeck 20 USPQ2d 1439, 1444, In re Ferens 163 USPQ 609).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is again rejected under 35 U.S.C. 103(a) as being unpatentable over Dekeyser et al. (US 4,670,555). The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. The reference teaches structurally similar compounds which are excluded by proviso. Compounds which are prima facie obvious over compounds of the reference are embraced by the claim. Thus, a prior art compound wherein R¹¹ is C2 chloroalkyl renders obvious a compound of the instant claim when R¹¹ represents a C3 chloroalkyl group.

Also, a prior art compound where R¹¹ is a C2 bromoalkyl renders obvious the compound of the instant claim where R¹¹ is a C2 iodoalkyl group because one halogen renders another halogen prima facie obvious.

Applicant's declaration is noted. However, Applicants have not tested the closest prior art compounds against the closest claimed compounds identified above. The declaration is not commensurate in scope with the breadth of the claims. Sample numbers 074 and 125 have a pyridyl group; the prior art compounds do not.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 703-305-4484.

The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 703-308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
September 19, 2003